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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,216	06/24/2004	Yuichi Hikichi	61534 (46342)	3278

21874 7590 09/14/2005

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EXAMINER

VIVLEMORE, TRACY ANN

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/500,216

Applicant(s)

HIKICHI ET AL.

Examiner

Tracy Vivlemore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 in part, 6, 10 and 17, drawn to a compound that inhibits activity of a protein having the same or substantially the same sequence as that shown in SEQ ID NO: 1.

Group II, claim(s) 1 in part, 2-4, 6, 11 and 18, drawn to a compound that inhibits expression of a gene for a protein having the same or substantially the same sequence as that shown in SEQ ID NO: 1 wherein the compound is an antisense nucleotide.

Group III, claim(s) 5-7 and 9, drawn to preventive/therapeutic agent for cancer that is an antibody to a protein having the same or substantially the same sequence as that shown in SEQ ID NO: 1.

Group IV, claim(s) 8, 9 and 15, drawn to a DNA encoding a protein that is the same or substantially the same sequence as that shown in SEQ ID NO: 1.

Group V, claim(s) 12 and 19, drawn to a method of screening for a preventive/therapeutic agent for cancer or an apoptosis inducer using the protein having the same or substantially the same sequence as that shown in SEQ ID NO: 1.

Group VI, claim(s) 13, drawn to a kit comprising a protein having the same or substantially the same sequence as that shown in SEQ ID NO: 1.

Group VII, claim(s) 14 and 20, drawn to a method of screening a preventive/therapeutic agent for cancer or an apoptosis inducer using a DNA encoding a protein having the same or substantially the same sequence as that shown in SEQ ID NO: 1.

Group VIII, claim(s) 16, drawn to a preventive/therapeutic agent for cancer as described in claim 16.

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Group IX, claim(s) 21, drawn to a method of preventing/treating cancer by administering a compound that inhibits activity or expression of a protein having the same or substantially the same sequence as that shown in SEQ ID NO: 1.

Group X, claim(s) 22, drawn to use of a compound that inhibits activity or expression of a protein having the same or substantially the same sequence as that shown in SEQ ID NO: 1 for an unstated purpose.

1. The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of group V is the use of a protein having the same or substantially the same sequence as that shown in SEQ ID NO: 1 to screen for a modulator of this protein, the special technical feature of group III is an antibody to the protein of SEQ ID NO: 1 and the special technical feature of group VIII is an agent identified by the method of group V. Each of these special technical features was known in the art prior to the filing of the instant application. See EP 1 162 274 A1 (cited on IDS), which discloses and claims a method of identifying modulators of SUV39H1 (the protein of SEQ ID NO: 1) using the protein; an antibody to the protein and anti-cancer agents identified by the claimed screening methods. Thus, the special technical features of groups V, III and VII are not a contribution over the prior art.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Vivlemore whose telephone number is 571-272-2914. The examiner can normally be reached on Mon-Fri 8:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Andrew Wang can be reached on 571-272-0811.

On July 15, 2005, the Central FAX Number was changed to 571-273-8300.

Faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent

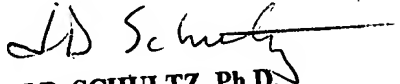
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Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Tracy Vivlemore
Examiner
Art Unit 1635

TV
September 6, 2005


J.D. SCHULTZ, Ph.D.
PATENT EXAMINER